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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/967,303 | 09/27/2001 | Kendra L. Dunlap | 10006386 | 5197 |

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EXAMINER

PESIN, BORIS M

ART UNIT

PAPER NUMBER

2174

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|-------------------------|---------------------|
| | 09/967,303 | DUNLAP ET AL. |
| | Examiner Boris Pesin | Art Unit 2174 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 August 2004.
2a) This action is **FINAL**. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-23 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION***Response to Amendment***

This communication is responsive to Amendment A, filed 08/03/2004.

Claims 1- 23 are pending in this application. Claims 1, 6, 14, and 21 are independent claims. In the Amendment A, Claim 2 was amended. This action is made Final.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8, 14-15, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word ("MS Word," see screen shots pages 1-5).

As per independent claim 1, the MS Word "What's This" tool teaches a method for accessing instructions on a device having a user interface, the method comprising the steps of: receiving a user-selection of a first help mode displayed on the user interface (page 1, figure 2), the selected first help mode allowing the user to choose an icon for identification of a function associated with the icon without invoking the function (page 2, figure 3); upon receiving a user-selection of the icon, displaying a help window including an identification of a function associated with the icon (page 2, figure 3). The MS Word "What's This" tool does not disclose a link to instructions related to accomplishing the function; and in response to user-selection of the link, displaying the instructions related to accomplishing the function.

The MS Word Help tool teaches a link to instructions related to accomplishing the function (page 4, figure 7); and in response to user-selection of the link, displaying the instructions related to accomplishing the function (pages 4-5, figures 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of the MS Word "What's This" tool to include a link to instruction related to a function and in response to user selection of the link displaying the instructions, as taught by the

MS Word Help tool, with the motivation to reduce the number of steps required to access help information.

Claims 6, 14, and 21 are similar in scope to claim 1, and are therefore rejected under similar rationale.

As per claim 2, which is dependent on claim 1, the MS Word “What’s This” tool teaches returning to the first help mode on the user interface after displaying the instructions, receiving a next selection of a different icon displaying a different help window including an identification of a next function associated with the different icon (page 2, figure 4). The MS Word “What’s This” tool does not disclose a next link to instructions related to accomplishing the next function; and in response to user-selection of the next link, displaying instructions related to accomplishing the next function.

The MS Word Help tool teaches a next link to instructions related to accomplishing the next function (page 4, figure 7); and in response to user-selection of the next link, displaying instructions related to accomplishing the next function (pages 4-5, figures 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of the MS Word “What’s This” tool to include a link to instruction related to a function and in response to user selection of the link displaying the instructions, as taught by the MS Word Help tool, with the motivation to reduce the number of steps required to access help information.

Claim 22 is similar in scope to claim 2, and is therefore rejected under similar rationale.

As per claim 3, which is dependent on claim 1, the MS Word “What’s This” tool teaches that the identification of a function associated with the icon includes a description of the function (page 2, figures 3-4).

As per claim 4, which is dependent on claim 1, the MS Word Help tool teaches that the instructions related to accomplishing the function include a series of steps a user executes to accomplish a task associated with the function (pages 4-5, figures 7-9).

As per claim 5, which is dependent on claim 1, MS Word teaches receiving a user-selection of a second help mode displayed on the interface (page 2, figure 5), the second help mode presenting a user with a list of help topics; receiving a user-selection for a help topic from the list; and displaying instructions for accomplishing a function related to the user-selected help topic (page 3, figure 6).

Claims 7, 15, and 23 are similar in scope to claim 5, and are therefore rejected under similar rationale.

As per claim 8, which is dependent on claim 7, the teachings of MS Word in regards to claim 7 have been discussed above. MS Word does not disclose that the user interface includes a touch screen, which accommodates user-selection of the help menu and subsequently user-selection of either of the first help mode and the second help mode. Official Notice is given that the use of a touch screen is notoriously well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of MS Word to include a touch screen input means with the

motivation to provide an intuitive interface that allows the user to use their finger to make selections.

Claims 9-13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word ("MS Word," see screen shots pages 1-5) in further view of Fang (US006628311B1).

As per claims 9-13, which are dependent on claim 8, the teachings of MS Word in regards to claim 8 have been discussed above. MS Word does not disclose the type of devices that can be used with this help system. Fang teaches that the device running a help system is an auxiliary device (column 1, lines 17-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of MS Word to include running a help system on a plurality of auxiliary devices, as taught by Fang, with the motivation to provide help on a plurality of devices that require user interaction.

Fang explicitly teaches that the auxiliary device may be a printer or a scanner (i.e. a image capture/creation device). However, he does not expressly disclose that the auxiliary device is a copier, a fax machine, a digital sender, or a multifunction peripheral. Official Notice is given that copiers, fax machines, digital senders, and multifunction peripherals are all forms of image capture/creation devices and are all well known auxiliary devices. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a copier, a fax machine, a digital sender, or a multifunction peripheral in the list of auxiliary devices taught by Fang with the motivation that all of these devices support image capture and creation.

Claims 16-20 are similar in scope to claims 9-13, respectively, and are therefore rejected under similar rationale.

Response to Arguments

Applicant's arguments filed 08/03/2004 have been fully considered but they are not persuasive.

The Applicant argues:

- a. It is not clear from the MS Word screen shots whether the icon is identified by a mouse-click, or simple placement of the cursor over the icon.
- b. It is unclear from the MS Word screen shots whether the icon functions are disabled upon selection of the "What's This?" tool.
- c. MS Word Screen Shots do not disclose instructions related to accomplishing the function associated with a selected icon and that there is no motivation to combine to make modifications to relate the different help operations.
- d. The combination of MS Word TOC and the "What's This?" tool would not result in a one to one relationship between 1) identification of a function associated with an icon, and 2) instructions related to accomplishing the function associated with the icon.
- e. It's not clear that the topics in the TOC tool of the MS Word screen shots correlate to the selectable icons.

f. Claims 6, 14 and 21 are worthy of separate treatment because they are different.

g. The Examiner's official notice is incorrect and that the use of a touch screen is not well known in the art.

In regards to argument (a), the icon is identifiable by both, hovering over the icon and by pressing the mouse button. If one hovers over the icon a short description of the button appears. If one clicks on the button a more detailed description appears.

In regards to argument (b), the icon is disabled after the user presses the "What's This?" button. The icon is disabled so that the user can press the mouse button and get a detailed description of the button and not activate the normal use of the button.

In regard to argument (c), the MS Word screen shots do disclose instructions related to accomplishing the function associated with a selected icon as illustrated in Figure 7.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or** in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) (Emphasis added). In this case, the motivation to reduce the number of steps required to access help information is knowledge generally available to one of ordinary skill in the art.

In regards to argument (d), MS Word TOC and the "What's This?" tool would result in a one-to-one relationship because the combination would allow the TOC tool to open showing a detailed instructions related to accomplishing the function associated with an icon. ^{KK}

In regards to argument (e), the TOC tool of the MS Word screen shots correlate to the selectable icons. The TOC tool includes more information than just for the icons, but it does have information on the icons.

In regards to argument (f), claims 6, 14 and 21 are similar in scope and were treated separately; however in the interest of having a clear and concise Office action, a separate detailed rejection was not written since it would have been identical to the Claim 1 rejection. The hardware aspects of claim 6 are inherent in MS Word.

In regards to argument (g), having a touch screen display is a well-known fact that is capable of instant and unquestionable demonstration as being well known in the art. Therefore, it is not an improper official notice. The following are all patents showing a tablet computer with a touch screen display that can be used to accommodate selection of an icon for identification of an associated function in a help menu.

Art Unit: 2174

US 6166734

US 6084584

US 6052120

US 6018336

US 5757361

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Pesin whose telephone number is (571)

Art Unit: 2174

272-4070. The examiner can normally be reached on Monday-Friday except every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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